

Application No.: 09/647,748

Case No.: 54030US008

Remarks

Claims 1-3, 5 and 6 are pending.

§ 112 Rejections

Claim 6 stands rejected under 35 USC § 112, first paragraph, as based on a disclosure which is not enabling.

Applicant directs the Examiner to page 5, lines 17-19 of the application as filed. Claim 6 is properly enabled in the specification. The Examiner states that the length and composition of the short fibers are critical or essential to the invention. However, the Applicant directs the Examiner to the Summary of the Invention, page 3, lines 20-24. The present invention comprises double-layer paper structure manufactured from wood pulp and short fibers. Therefore, the critical aspect of the short fibers is already included in the present claim.

In summary, Applicant submits that the rejection of claim 1 under 35 USC § 112, first paragraph, has been overcome, and that the rejection should be withdrawn.

§ 103 Rejections

Claims 1-3, 5 and 6 stand rejected under 35 USC § 103(a) as being unpatentable over Nitto Denko Corp. in view of Canary.

The Examiner has made an unsound presentation of obviousness. The Examiner has never shown that each and every element of the claimed invention is present in the art of record. No reference teaches short fibers having **both** a length within the range of about 3 to 20 mm **and** comprising a material selected from polyvinyl alcohol, polyamide, polyester, polyethylene, polypropylene, polyurethane, polyvinyl chloride, polyvinylidene chloride, polyacrylonitrile, rayon, or combinations thereof. Therefore, the Examiner has not met the burden of showing a *prima facie* case of obviousness.

The Examiner repeats that Canary teaches wood pulp fibers with a length between 2 and 5 mm. Applicant has never argued otherwise. The issue is not what Canary teaches, but what Canary fails to teach. Canary fails to teach short fibers (i.e. 3 to 20 mm) that *also have*, as one component, polyvinyl alcohol, polyamide, polyester, polyethylene, polypropylene, polyurethane,

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polyvinyl chloride, polyvinylidene chloride, polyacrylonitrile, rayon, or combinations thereof. Canary's **wood** fibers do not have such a component.

The Examiner's error is in stating that the term comprising fails to limit our reference to non-wood pulp fibers. The mere fact that the Applicant has not excluded the wood pulp is irrelevant, since Canary fails to teach elements of the present invention.

Applicant is aware that the prior art is irrelevant to whether a Markush group is open ended. However, Applicant submits that the Markush group is closed and proper. The material is the subject of the Markush limitation, not the fibers in total. However, the fibers must contain at least one of the materials as listed and limited by the Markush group.

Applicant invites the Examiner to discuss the claim with the Applicant.

Both independent claims 1 and 2 contain the limitation on the short fibers. Claims 1 and 2 are patentable for the reasons set forth above and in prior responses. Claim 3 depends from claim 2.

The Examiner additionally rejected claim 6. However, the Applicant directs the Examiner to Column 1, lines 5-13 of the Canary reference. While the Examiner's listing of the amounts of polyolefin is correct, Canary teaches that in one layer, the quantity of polyolefin is greater than the quantity of wood pulp. Therefore, Canary fails to teach this element of new claim 6.

The rejection of claims 1-3, 5 and 6 under 35 USC § 103(a) as being unpatentable over Nitto Denko Corp. in view of Canary has been overcome and should be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Allowance of claims 1-3, 5 and 6, as amended, at an early date is solicited.

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Date

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